

fluorinated surfactant. The ink must thus contain a fluorinated surfactant, colorant and a vehicle. The composition can also contain a plethora of other materials, all of which are optional. Twenty-one (21) categories of such optional materials are set forth in [0021]. One category is “polymerizable materials” and those materials may (or may not) include monomers, oligomers and/or polymers. Ylitalo teaches in [0080] that solvents, which may be aqueous or organic, when present, are chosen to provide desired physical properties such as viscosity, and the like, and when the ink is radiation curable, are desirably absent. As the Examiner has acknowledged, Ylitalo fails to teach or suggest any solvent-soluble resin can be present. The rejection therefore relies upon Subbaraman.

Subbaraman describes a non-aqueous, non-pigmented ink “containing only solvents and solvent soluble resins and dyes that exhibit acceptable characteristics of opacity, contrast, adhesion and machine compatibility” in which the “differential solubilities of the resins in the solvent-blend is the prime moving factor of the opacifying action.” (Abstract). There is no teaching or suggestion in Subbaraman of the presence of an energy curable monomer, oligomer or mixture, and quite to the contrary, the Subbaraman composition is designed to cure by drying. See, e.g., column 3, line 23, and column 13, line 45 to column 14, line 3.

The Supreme Court in *KSR*, and subsequent Federal Circuit cases have made it clear that there must be some stated reason to extract a teaching from a secondary reference and incorporate it into the relevant part of the primary reference. Since Ylitalo’s composition may or may not contain an energy-curable material, there must be a valid reason here to extract some teaching from Subbaraman and incorporate it into Ylitalo when the Ylitalo composition contains an energy-curable material. There is no such reason.

The Advisory Action proposes that the Subbaraman's statement that the quantity of resin is chosen to realize a desired viscosity, adhesion, opacity and adhesion, provides that reason. Applicant respectfully disagrees. While those may be a reason to incorporate the solvent-soluble resin in a composition which contains solvent and cures by drying, it does not constitute a reason to incorporate such a resin in a composition which cures by a different mechanism, namely polymerization or cross-linking, thereby requiring the presence of a photoinitiator [0086], and is preferably solvent-free [0080], such as the energy curable compositions of Ylitalo. The reason proposed in the Advisory Action assumes the Ylitalo composition needs to add something to provide those characteristics but it is clear from Ylitalo' disclosure (e.g., [0080]) that the materials disclosed in that reference are being selected to provide them. In other words, the proposed reason is to correct a deficiency that does not exist. Further, why would one incorporate a solvent-soluble resin in the radiation curable composition which Ylitalo teaches should not contain a solvent?

A reason to use something in one reference is not, *ipso facto*, a reason to use it in a completely different set of circumstances. If there was a reason to use the material in the different type of composition, that reason must be related to providing a characteristic which is either not present or inadequate, taking compatibility with composition into consideration. Neither is true here. The proposed characteristic is already present in Ylitalo and is not inadequate. The "prime moving factor" for using the solvent soluble resin in Subbaraman, namely the differential solubility in the solvent blend, is absent because solvent is desirably absent in Ylitalo.

Since no valid reason exists for extracting a solvent-soluble resin from Subbaraman (or any other reference for that matter) and incorporating it into an energy

curable composition, it is respectfully submitted that the proposed combination is improper and a rejection based on it would be untenable.

In view of the above remarks, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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